

Doc Code: AP.PRE.REQ

AUG 03 2009

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LORWER P37AUS

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on 08/03/2009Signature Claire ZopfTyped or printed name CLAIRE ZOPF

Application Number

10/533,108

Filed

05/27/2005

First Named Inventor

Josef Weiland

Art Unit

3727

Examiner

Muller, Bryan R

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

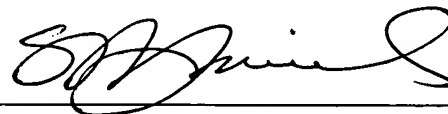
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Registration number if acting under 37 CFR 1.34



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Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

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August 3, 2009

LORWER P37AUS
Customer No. 84386



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Josef WEILAND

DEVICE AND METHOD FOR
MACHINING WORKPIECES

Serial No. 10/533,108

Filed 05/27/2005

Group Art Unit: 3723

Examiner: Bryan Muller

Confirmation No.: 4794

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

Pre-Appeal Brief

In response to the Official Action mailed May 4, 2009 it is the Applicant's position that the rejection of claims 39-44, 48-50, 52, 53, 55-75 and 85, under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, and consequently the rejection of claims 39-42, 46, 48-50, 57-61, 71-74 and 78 for obviousness under 35 U.S.C. § 103(a) is made in error.

The Applicant's claimed invention relates to an apparatus for fully machining a metallic workpiece, for example machining a metal plate to remove an oxidation layer from the entire metal plate, and in particular, to machine and remove this oxidation layer from cut surfaces and edges of the metal plate. See Para. [016] of Applicant's Specification.

As discussed in the Applicant's specification at paragraphs [007]-[010] laser cutting of a metal plate leaves an oxide layer on the cut surfaces and edges. It is very difficult to remove, i.e. machine, this oxide layer from the metal plate. In particular, it is very difficult to remove

this oxide layer from inner cut surfaces and edges of cut-outs, holes and apertures cut in the metal plate. The Applicant's specification at paragraph [011], last sentence, also points out that the known brushes and rollers are prevented for various reasons from penetrating into and machining such cut-outs, holes or apertures in the metal plate.

To accentuate the ability of the presently claimed invention to penetrate deeply into such cut-outs, holes and apertures to machine these cut surfaces and edges of the metal plate, in a Response dated October 2, 2008 the Applicant amended claim 39 to include the feature;

..wherein the at least one brush of each of the first and second conveyor devices *machine substantially all the edge surface* of the workpiece in opposite directions, and the at least one brush of each of the third and fourth conveyor devices machine substantially all the edge surface of the workpiece in opposite directions.¹ (Emphasis Added)

In rejecting claim 39, and more specifically this amendment, the Official Action interprets this amended phrase of claim 39 expressly that, “..under the broadest reasonable interpretation of the term ‘substantially all’ meaning at least portions of the edge surface are machined.” As the Applicant understands this argument, the Examiner is not giving the term “substantially” the complete breadth and meaning to which the term is entitled, but is in fact limiting the Applicant's disclosure, and thus this term “substantially all” to include only “a portion” of the edge surface.

The Applicant adamantly disagrees. The term “substantially all” should be given its broadest interpretation which would include not only “portions” of the edge surface, but *all* the edge surface.

The Official Action states that “[a]t most, the original specification supports that the edge surface is machined but there is no sufficient support that *substantially all* of the edge surface is machined by each pair of the first and second conveyor devices and the third and fourth conveyor devices.” (Emphasis Added.)

¹ Claim 46 recites similar claim language, “wherein the at least one brush of each of the first and second conveyor devices machine the respective first and second main surfaces and the edge surface of the workpiece in opposite directions to ensure *that the edge surface of the workpiece is entirely machined.*”

Actually, what the original specification recites at paragraph [020] is:

[20] The inventor has discovered that, surprisingly, the linear profile of the brush in the region of the workpiece to be machined ensures that the brush penetrates into all cutouts or holes in the workpiece and therefore removes the oxide layer at all cut surfaces and cut edges.
(Emphasis Added.)

It is the Applicant's position that the clause "...at all cut surfaces and cut edges" is not limited to only "some" or "a portion" of the surfaces or edges. The express meaning of "all" is including the whole, or entire cut surface and side edge. The Merriam-Webster Online Dictionary defines "all" as, 1 a: the whole amount, quantity, or extent of <needed *all* the courage they had> <sat up *all* night>.

Besides being express, it is a reasonable interpretation of this clause to include not only a portion, but all, i.e. the entire and complete cut surface and cut edges.² That the claim term *substantially all* should be given its broadest interpretation to include a "portion" and "all" of the entire surface makes complete sense, and is entirely reasonable, especially when interpreted in light of the context of the entire disclosure. In the Applicant's Summary of the Invention at paragraph [021] it is explained that:

[21] It is advantageous for the apparatus according to the invention to machine the surfaces, i.e. the main surfaces of the metallic workpieces in strip or plate form and also to descale the cut surfaces and cut edges. Simultaneous descaling of the cut surfaces and cut edges and cleaning of the main surfaces was not possible with the apparatuses which have been disclosed hitherto.

Clearly the disclosure explains and describes an apparatus intended for removing the entire oxide layer on the entirety of the cut surfaces and edges surfaces of the metal workpiece. If this was not the case, the entire purpose of the claimed apparatus would be moot since it is conventionally known to undertake a number of subsequent machining steps on different machines to remove the oxide layers from all the cut surfaces of the metal plate. Please see Applicant's Background of the Invention at paragraph [009]. Also, paragraphs [069] – [070] of

² Claim 76 recites, "ensuring contact and *complete machining* of the edge surface..."

the Detailed Description discuss expressly that the workpiece is fully machined in a single pass.

With regards to the term “substantially” the MPEP states unequivocally that this is a broad term. See MPEP 2175.03(b)(D). Nothing in the Applicant’s disclosure indicates a limit to the breadth of this term. The Official Action at a Note on page 7 supports the limiting of this term by the following interpretation of the same paragraph [020], “..paragraph 20, as cited by the applicant, states that edges are machined, but does not further disclose that all of or even that any specific amount of the edges are actually machined.” On the contrary, Applicant’s paragraph [020] clearly states that, “the brush ...removes the oxide layer at all cut surfaces and cut edges.” Paragraphs [069] – [070] of the Detailed Description, last line, recites that the workpiece is “fully machined” in a single pass.

If the Examiner’s argument is true, then there is no definite disclosure of removal of the oxide layer in any amount from the cut surfaces and edges and the entire claimed and disclosed invention would be indefinite.

The Applicant respectfully asserts that the disclosure, as read expressly and in the context of the Drawings, Background, Summary and Detailed Description of the invention clearly and unequivocally discloses removal of substantially all the oxide layer from the cut surfaces and edges of the metal workpiece.

From MPEP 2111.01 “during examination, the claims must be interpreted as broadly as their terms reasonably allow.” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004); *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The scope of the invention is determined according to the ordinary and customary meaning of the claim terms and it is this intrinsic evidence that is the most significant source of the legally operative meaning of the claim language. See *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996), *cit. omit.* Claim terms will be given their ordinary and customary meaning, unless the inventor appeared to use

such words differently. See *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 326 F.3d 1215, 1220 (Fed. Cir. 2003); *Allen Engineering Corp.*, 299 F.3d at 1344.

The Applicant's position is that the claim phrase, "substantially all the edge surface of the workpiece" is to be given its complete breadth as indicated in the specification and is specifically and expressly supported by paragraph [020] as well as the entirety of the Applicant's disclosure both express and inherent to remove all the oxide layer from all the cut surfaces and edges. The claim language therefore complies with the written description requirement and the claim rejection under 35 USC § 112, 1st paragraph is made in error.

Finally, given the clear breadth of the disputed claim term with respect to the obviousness rejection of claims 39-42, 46, 48-50, 57-61, 63, 71-74 and 78 under 35 U.S.C. § 103(a), as none of the references either alone, or in combination disclose, teach or suggest an apparatus with opposing conveyor brushes which can "machine substantially all the edge surface of the workpiece in opposite directions," it is respectfully requested that the 35 U.S.C. § 103(a) rejections also be withdrawn.

Respectfully submitted,
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